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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09-879,532	06-12-2001	Stephen M. Hoyles	60638A	3203

109 7590 04-11-2003

THE DOW CHEMICAL COMPANY
INTELLECTUAL PROPERTY SECTION
P. O. BOX 1967
MIDLAND, MI 48641-1967

EXAMINER

SELLERS, ROBERT E

ART UNIT	PAPER NUMBER
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1712

DATE MAILED: 04-11-2003

8

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/879,532

Applicant(s)

HOYLES ET AL

Examiner

Robert Sellers

Art Unit

1712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 24 March 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-3 and 5-31 is/are pending in the application.
- 4a) Of the above claim(s) 12-25 and 27-30 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1-3, 5-11, 26 and 31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5 6) ☐ Other:

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Claims 12-25 and 27-29 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to nonelected inventions, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 7.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-3, 5-11, 26, 30 and 31 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The designation of the epoxy or phenolic functional oligomer as a "polyether/polyester" on page 3, lines 14 and 20; page 5, line 31; page 8, lines 21 and 31 is misleading since such terminology presupposes the required presence of both polyether and polyester moieties. Since the oligomer is produce via a reaction involving either a diglycidyl ether or diglycidyl ester, it would be more concisely named as an "epoxy or phenolic functional polyether **or** polyester [emphasis added]."

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The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-3, 5-11, 26, 30 and 31 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The designation of the epoxy or phenolic functional oligomer as a "polyether/polyester" is misleading since such terminology presupposes the required presence of both polyether and polyester moieties. Since the oligomer is produce via a reaction involving either a diglycidyl ether or diglycidyl ester, it would be more concisely named as an "epoxy or phenolic functional polyether **or** polyester [emphasis added]."

The phrase "selected from" in claims 2, 3 and 5-11 is improper Markush language in the absence of the limitation "selected from the group consisting of."

There is no antecedent basis in claim 1 for the catalyst of claims 9-11.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-3, 5-11, 26, 30 and 31 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-7, 16-18, 28, 31 and 32 of Application No. 10/007,518 as represented by U.S. Patent Publication No. 2002/0128428. The application has been allowed. Both applications possess the common assignee of the Dow Chemical Company as indicated by the common correspondence address for Publication No. 2002/0128428 and Publication No. 2002/0042493 which is the published application for the instant application.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the controlled conversion epoxy resin of Application No. 10/007,518 is derived from the identical reactants of an epoxy resin such as a diglycidyl ether or ester, a dihydric phenol such as bisphenol A (i.e. the 4,4'-isopropylidene bisphenol of claim 5, and an anhydride such as the phthalic anhydride of claim 6.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

The closest prior art is embodied in Koenig et al. and the Pham et al. as represented by U.S. Patent No. 4,981,926. Koenig et al. discloses the branching of a bisphenol-advanced diglycidyl ether in the presence of a lithium or cesium branching catalyst. Pham et al. '926 sets forth the advancement of a diglycidyl ether or ester with a bisphenol and a minor amount of a compound having more than two epoxy-reactive hydrogen atoms such as phenolic resins. Neither of the references recite the claimed anhydride reactant, nor is there any motivation to employ such a compound.

(703) 308-2399 (Fax no. (703) 872-9310) Monday to Friday, 9:30 to 6:00 rs 4/9/03


ROBERT E. L. SELLERS
PRIMARY EXAMINER